

REMARKS/ARGUMENTS

This Amendment is in response to the Final Office Action mailed October 14, 2008. Claims 1 and 3-12 were pending in the present application. This Amendment adds new claims 13 and 14, leaving pending in the application claims 1 and 3-14. Applicants submit that no new matter has been introduced by virtue of these amendments. Reconsideration of the rejected claims is respectfully requested.

Statutory Double Patenting Rejection of Claim 1

Claim 1 is provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claim 1 of co-pending U.S. Patent Application No. 10/946,146 (hereinafter “the ‘146 application”), filed September 20, 2004. Applicants respectfully traverse the rejection.

Per the MPEP:

In determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? 35 U.S.C. 101 prevents two patents from issuing on the same invention. “Same invention” means identical subject matter. Miller v. Eagle Mfg. Co., 151 U.S. 186 (1984); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

(MPEP §804(II)(A); emphasis added).

In the present case, Applicants submit that the claims in question (claim 1 of the present application and claim 1 of the ‘146 application) recite substantially different features, and thus cannot be considered the same invention under Section 101.

For example, claim 1 of the present application recites, in part: “creat[ing] a report identifying at least one employee in the set of employees that is simultaneously assigned to business functions that are identified as incompatible as per the at least one business function incompatibility.” Applicants submit that the specific feature of creating a report identifying employees simultaneously assigned to incompatible business functions is not recited in claim 1 of the ‘146 application.

Further, claim 1 of the ‘146 application recites, in part: “creat[ing] an alert identifying at least one risk with respect to the operations of the enterprise, wherein the at least

one risk is associated with a business function incompatibility in the compatibility registry...” Applicants submit that the specific feature of creating an alert identifying a risk with respect to the operations of an enterprise, where the risk is associated with a business function incompatibility is not recited in claim 1 of the present application.

Since claim 1 of the present application recites features that are not recited in claim 1 of the ‘146 application (and vice versa), Applicants submit that the statutory double patenting rejection of claim 1 is in error. Accordingly, Applicants respectfully request that the rejection be withdrawn.

35 U.S.C. §112 Rejection of Claims 1 and 3-12

Claims 1 and 3-12 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. In particular, the Office Action asserts:

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonable convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention...

The added material which is not supported by the original disclosure is as follows:

- i. The newly recited claim limitation in Claim 1 “...a storage component configured to store...” appears to constitute new matter.
- ii. The newly recited claim limitation in Claim 1 “...create a report identifying at least one employee ‘in the set of employees’ that is simultaneously assigned to business functions that are identified as incompatible as per the at least one business function incompatibility...” appears to constitute new matter.
- iii. The newly recited claim limitation in Claim 1 “...simultaneously assigned...” appears to constitute new matter.
- iv. The newly recited claim limitation in Claims 1 and 4 “...in the set of employees...” appears to constitute new matter.

(Office Action: pg. 3; emphasis in original).

Applicants respectfully traverse the rejection.

With respect to (i), support may be found in the Specification at, for example, paragraph 19 and FIG. 1. With respect to (ii) and (iii), support may be found in the Specification

at, for example, paragraphs 118-120. With respect to (iv), support may be found in the Specification at, for example, paragraph 120.

Accordingly, Applicants respectfully request that the Section 112 rejection of these claims be withdrawn.

35 U.S.C. §101 Rejection of Claim 1

Claim 1 is rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. In particular, the Office Action asserts:

The aforementioned claim is directed toward providing information in relation to an electronic communication device via a data signal. However, under the current guidelines of 35 USC 101, computer software must be tangibly embodied on a computer readable medium, and, when executed by a computer processor, perform the steps of the software. In its broadest reasonable interpretation and in light of the specification, claim 1 as recited can be interpreted to be embodied on abstract mediums such as carrier waves and signals, and therefore not eligible for patent protection.

(Office Action: pg. 4; emphasis in original).

Applicants respectfully traverse the rejection.

As best understood, the Office Action construes Applicants' claim 1 as corresponding to computer software *per se*. This is incorrect. As clearly recited, claim 1 is directed to an audit system comprising structural components such as a storage component and a processing component. An example of such an audit system (and its components) is described in the Specification at, for example, paragraphs 15-21 and FIG. 1.

Since claim 1 is directed to a physical system rather than software, Applicants submit that claim 1 recites statutory subject matter and respectfully requests that the Section 101 rejection of this claim be withdrawn.

35 U.S.C. §103 Rejection of Claims 1 and 8-12

Claims 1 and 8-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Wefers et al. (International Publication No. WO 2005/055098, hereinafter "Wefers") in

view of Kahn (U.S. Patent No. 7,185,192, hereinafter “Kahn”), and in further view of Paulus et al. (U.S. Patent No. 7,246,137, hereinafter “Paulus”). Applicants respectfully traverse the rejection.

Applicants’ independent claim 1 recites:

An audit system comprising:

a storage component configured to store:

 a set of business processes describing the operations of an enterprise, each business process including one or more business functions, each business function being assigned to one or more employees in a set of employees; and

a compatibility registry including a set of business function incompatibilities, each business function incompatibility identifying at least two business functions that should not be simultaneously assigned to a single employee; and

 at least one processing component in communication with the storage component, the at least one processing component being configured to:

compare at least one business function incompatibility in the compatibility registry with the business functions assigned to each employee in the set of employees; and

 create a report identifying at least one employee in the set of employees that is simultaneously assigned to business functions that are identified as incompatible as per the at least one business function incompatibility.

(Applicants’ independent claim 1, emphasis added).

Applicants respectfully submit that the features of claim 1 are not taught or suggested by Wefers, Kahn, or Paulus, considered individually or in combination.

For example, Wefers, Kahn, and Paulus fail to teach or suggest “a storage component configured to store:... a compatibility registry including a set of business function incompatibilities, each business function incompatibility identifying at least two business functions that should not be simultaneously assigned to a single employee” as recited in claim 1. The Office Action does not identify any section of Wefers or Paulus that teaches this feature. However, the Office Action asserts that this feature is shown in Kahn at paragraph 15. (Office Action: pg. 8). Applicants respectfully disagree.

The cited section of Kahn states:

The invention is based in part on the observation that most computing system environments allow a single user to act in different roles. Some users may require limited access to various computing system resources at certain times, while the same or other users might require more involved or more open access to resources at the same or at different times. A user may be acting in a role (e.g., as a payroll database administrator) on a computer system that conflicts with the access control permissions of other roles that the same, or a different user, is able to act in (e.g., as an employee). As a simple example, as an employee, a user should not be able to access payroll data in certain manners (e.g., read or modify) for security reasons, but as an administrator of the payroll database, the user's job may be to maintain (e.g., backup, copy, establish a mirror copy, etc., but not specifically change or even read) data within the payroll database, including data related to that or another users salary, bonus, and the like. It should be clear that a conflict of interest arises in this situation since only limited access to the data might be required. The invention helps to impose proper access control and authorization mechanisms in such a scenario.

(Kahn: col. 11, lines 24-44).

As can be seen, this section merely makes the general observation that a conflict of interest may arise when a user acting in one role (e.g., payroll database administrator) has access to certain resources (e.g., read/write privilege for payroll information) that he/she should not have access to when acting in different role (e.g., employee). Nowhere does this section (or any section) of Kahn make any reference to the specific concept of storing a registry of business function incompatibilities as recited in Applicants' claim 1. Further, nowhere does Kahn indicate that such a registry would be necessary to implement the invention described therein. Accordingly, Kahn fails to teach or suggest "a storage component configured to store:... a compatibility registry including a set of business function incompatibilities, each business function incompatibility identifying at least two business functions that should not be simultaneously assigned to a single employee" as recited in claim 1.

Further, Wefers, Kahn, and Paulus fail to teach or suggest "at least one processing component being configured to:... compare at least one business function incompatibility in the compatibility registry with the business functions assigned to each employee in the set of employees" as recited in claim 1. The Office Action does not identify any section of Kahn or Paulus that teaches this feature. However, the Office Action asserts that this feature is shown in

Wefers at claim 8 and paragraphs 65-69. (Office Action: pgs. 7-8). Applicants respectfully disagree.

As an initial matter, Applicants note that the two sections of Wefers cited in the Office Action (claim 8 and paragraphs 65-69) appear to be unrelated. Claim 8 of Wefers recites “wherein the software performs processes for determining whether any tasks assigned to a given role has been uniquely assigned to another role.” In contrast, paragraphs 65-69 of Wefers describe a exemplary “business process catalog” (e.g., 500 of FIG. 5 of Wefers) and exemplary relationships between business processes in a central catalog and financial statement accounts associated with an organization. Accordingly, it is unclear which section the Office Action is relying on to teach the “compare at least one business function incompatibility...” feature of Applicants’ claim 1.

To the extent that the Office Action relies on claim 8 of Wefers, Applicants submit that determining whether a task assigned to a role has been uniquely assigned to another role (as recited in claim 8 of Wefers) is substantially different from comparing a business function incompatibility stored in the compatibility registry with business functions assigned to each employee in a set of employees (as recited in Applicants’ claim 1). For example, claim 8 of Wefers merely refers to a “task”; the general notion of a task cannot be properly construed as teaching or suggesting a business function incompatibility, which identifies at least two business functions that should not be simultaneously assigned to a single employee as recited in Applicants’ claim 1. Accordingly, the act of determining whether a task is assigned to two different roles cannot be properly construed as teaching or suggesting “at least one processing component being configured to:... compare at least one business function incompatibility in the compatibility registry with the business functions assigned to each employee in the set of employees” as recited in Applicants’ claim 1. (Emphasis added).

For at least the foregoing reasons, even if Wefers, Kahn, and Paulus were combined (although there appears to be no rationale for combining), the resultant combination would not teach or suggest all of the features of claim 1. Accordingly, Applicants submit that

claim 1 is allowable over Wefers, Kahn, and Paulus, and respectfully request that the rejection of claim 1 be withdrawn.

Claims 8-12 depend (either directly or indirectly) from independent claim 1, and are thus believed to be allowable for at least a similar rationale as discussed for claim 1, and others.

35 U.S.C. §103 Rejection of Claim 3

Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Wefers, Kahn, and Paulus as applied to claim 1, and in further view of Morinville (U.S. Patent No. 7,185,010, hereinafter “Morinville”). Applicants respectfully traverse the rejection.

Claim 3 depends from independent claim 1, which is not rendered obvious by Wefers, Kahn, and Paulus as described above. As best understood, Morinville does not provide any teaching that would remedy the deficiencies of Wefers, Kahn, and Paulus in this regard. Thus, even if Wefers, Kahn, Paulus, and Morinville were combined (although there appears to be no rationale for combining), the resultant combination would not teach or suggest all of the features of claim 3. Accordingly, Applicants submit that claim 3 is allowable over Wefers, Kahn, Paulus, and Morinville, and respectfully request that the rejection of claim 3 be withdrawn.

35 U.S.C. §103 Rejection of Claims 4-7

Claims 4-7 are rejected under 35 U.S.C. §103(a) as being unpatentable over Wefers, Kahn, and Paulus as applied to claim 1, and in further view Morinville and Homsi (U.S. Patent No. 7,373,310, hereinafter “Homsi”). Applicants respectfully traverse the rejection.

Claims 4-7 depend from independent claim 1, which are not rendered obvious by Wefers, Kahn, and Paulus as described above. As best understood, Morinville and Homsi does not provide any teaching that would remedy the deficiencies of Wefers, Kahn, and Paulus in this regard. Thus, claims 4-7 are allowable for at least a similar rationale as discussed for claim 1.

In addition, Applicants submit that claims 4-7 recite additional features that distinguish over the cited art. For example, claim 7 recites, in part “wherein the at least one processing component is further configured to receive a selection from an auditor of a business process from the business process library and, in response to the selection, add the selected business process to the set of business processes describing the operations of the enterprise and add at least one business function incompatibility to the compatibility registry.” The Office Action does not identify any section of Wefers, Kahn, Paulus, or Homsi that teaches these features. However, the Office Action asserts that these features are shown in Morinville at paragraphs 47-50. (Office Action: pgs. 13-14). Applicants respectfully disagree.

As best understood, the cited section of Morinville describes a technique for extracting data from process audit logs into a data warehouse and then performing data mining on the warehouse data to identify patterns across instances of process executions. The cited section makes absolutely no reference to, for example, receiving a selection from an auditor of a business process in a business process library, or adding the selecting business process to a set of business processes defined for an enterprise, or adding a business function incompatibility to a compatibility registry. Accordingly, the cited section necessarily fails to teach or suggest “wherein the at least one processing component is further configured to receive a selection from an auditor of a business process from the business process library and, in response to the selection, add the selected business process to the set of business processes describing the operations of the enterprise and add at least one business function incompatibility to the compatibility registry” as recited in claim 7.

For at least the foregoing reasons, Applicants submit that claims 4-7 are allowable over the cited art, and respectfully request that the rejection of these claims be withdrawn.

New Claims 13 and 14

Claims 13 and 14 have been added to cover various embodiments of the present invention. Applicants submit that claims 13 and 14 do not introduce any new matter. Merely by

way of example, support for the features of claims 13 and 14 may be found in the Specification at, for instance, paragraphs 118-119.

Applicants submit that the features of claims 13 and 14 are not taught or suggested by the cited art. For example, claim 13 recites, in part: “receive[ing], from an auditor, a selection of a business process from the business process library,” “add[ing] the selected business process to the set of business processes describing the operations of the enterprise,” and “add[ing] a business function included in the selected business process and its associated list of incompatible business functions to the business function compatibility registry.” And claim 14 recites, in part: “wherein at least one business process in the business process library includes a parent business function and a child business function,” and “wherein the child business function inherits the list of incompatible business functions associated with the parent business function.” No disclosure pertaining to these features could be found in Wefers, Kahn, Paulus, Morinville, and/or Homsi.

Accordingly, Applicants respectfully submit that claims 13 and 14 are in condition for allowance.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

/Andrew J. Lee/

Andrew J. Lee
Reg. No. 60,371

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 415-576-0300
A2L:m4g